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PATENT

Customer No. 22,852
Attorney Docket No. 02481.1751

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Cordula HOPMANN, et al.) Group Art Unit: 1623
)
Application No.: 09/966,109) Examiner: Elli Peselev
)
Filed: October 1, 2001)
)
For: CITRULLIMYCINES, A PROCESS)
FOR THEIR PRODUCTION AND)
THEIR USE AS)
PHARMACEUTICALS)

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Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

In response to the Office Action dated December 6, 2002, (Office Action), Applicants respectfully request reconsideration of this application in view of the following remarks. Claims 1-22 are pending in this application. In the Office Action, the Office required restriction under 35 U.S.C. § 121 between the following groups of claims:

Group I: Claims 1-15 and 18-21, drawn to citrullimycines; and

Group II: Claims 16-17 and 22, drawn to a fermentation process for preparing citrullimycines.

The Restriction Requirement is respectfully traversed. However, to be fully responsive, Applicants provisionally elect, with traverse, the subject matter of Group I, claims 1-15 and 18-21.

In the Office Action, the Office failed to indicate the reason why the joint examination of claims from Groups I and II would be a serious burden, other than to mention that the inventions are distinct. The Office's attention is respectfully directed to M.P.E.P. § 803, which sets forth criteria and guidelines for the Office to follow in making a proper requirement for restriction. The M.P.E.P. instructs the Office as follows:

If the search and examination of an entire application can be made without **serious** burden, the Office must examine it on the merits, **even though it includes claims to distinct or independent inventions.** M.P.E.P. § 803 (emphasis added).

Applicants traverse the restriction requirement on the grounds that the Examiner has not shown that there would be a **serious** burden to examine Groups I and II together, despite the statement that a prior art search of these groups includes different areas of classification. Applicants submit that a joint search of Groups I and II would not be burdensome because claims 16 and 17 (part of Group II) depend from claim 1 (part of Group I) and therefore contain subject matter whose proper search would overlap with the search of Group I. Accordingly, Applicants respectfully request that, at the minimum, claims 1-15 and 18-21 (the claims of Group I) and claims 16 and 17 be examined together. Similarly, claim 22 is drawn to a microorganism mentioned in the claims of Group I and, therefore, also contains subject matter whose search would overlap with a proper search of the claims of Group I. Accordingly, Applicants respectfully request that the Office examine all pending claims in this application together.

Because the Office has not established that the joint examination of claims from Groups I and II would be a serious burden, Applicants submit that the Office has not established a *prima facie* case of serious burden of search. Therefore, Applicants respectfully request that the restriction requirement be withdrawn.

Furthermore, Applicants respectfully remind the Office that in view of the court findings in *In Re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), claims directed to processes of making or using a compound are subject to rejoinder with claims drawn to that compound once the compound is found patentable. See also M.P.E.P. §§ 821.04 and 2116.01.

Pursuant to the above-referenced rejoinder procedure, Applicants respectfully request that at least claims 1-21 be examined together in this application.

Should the Office consider that a telephone conference with Applicants' representative would expedite prosecution of this application, the Office is encouraged to contact the undersigned at (202) 408-4123.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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Dated: January 2, 2003